



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,631	09/30/2003	Kenneth D. Nelson	T-6133 (538-56)	6068

7590 03/17/2006

Michael E. Carmen, Esq.
M. CARMEN & ASSOCIATES, PLLC
Suite 400
170 Old Country Road
Mineola, NY 11501

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,631

Applicant(s)

NELSON ET AL.

Examiner

Patrick D. Niland

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-75 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/05, 1/04, 2/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1714

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-75 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6632781 Harrison et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the claims differ somewhat in scope, the patented claims encompass the instant claims. Note particularly the polymeric compounds of claim 15 of the patentee.

3. Claims 9, 30, and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. It is unclear what the reduced color is relative to, e.g. a composition which is less dilute in color contributing compounds or some other thing.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1714

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 14, 18-23, 26, 30-37, 39-51, 54, and 58-62 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 271337 B1 Ohtake et al..

Ohtake discloses the inventions of the instant claims at the abstract; page 2, lines 3-7; page 3, lines 43-58; page 5, lines 39-58; page 6, lines 1-58, particularly 4, 17-25, and 26-41 of which “colloidal” is taken as indicating the instantly claimed particle size of claims 10-11, 31-32, 58-59, page 7, lines 1-22, particularly 17-22, which falls within the scope of the dispersing agents and detergents of the instant claims 1, 14, 18, 26 page 9, lines 35-58 which encompasses the instant claims 35-37, 39; page 10, lines 1-58; page 11, lines 1-58 of which the amount of water per amount of polymolybdate falls within the scope of the instant claims 7-8 and 33-34, 60; and the remainder of the document. The resulting composition will have a reduced color of the instant claims 9, 30, and 62 relative to a composition containing more concentrated amounts of the colored compounds of Ohtake or compositions containing larger particle sizes than those of Ohtake based on the Tyndall effect expected in Ohtake which gives a milky color, i.e. reduced color.

Art Unit: 1714

7. Claims 1-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 271337 B1 Ohtake et al. in view of US Pat.No. 3223625 Cyphers et al. and EP 602863 Blackborow et al..

Ohtake discloses the inventions of the instant claims at the abstract; page 2, lines 3-7; page 3, lines 43-58; page 5, lines 39-58; page 6, lines 1-58, particularly 4, 17-25, and 26-41 of which "colloidal" is taken as indicating the instantly claimed particle size of claims 10-11, 31-32, 58-59, page 7, lines 1-22, particularly 17-22, which falls within the scope of the dispersing agents and detergents of the instant claims 1, 14, 18, 26 page 9, lines 35-58 which encompasses the instant claims 35-37, 39; page 10, lines 1-58; page 11, lines 1-58 of which the amount of water per amount of polymolybdate falls within the scope of the instant claims 7-8 and 33-34, 60; and the remainder of the document. The resulting composition will have a reduced color of the instant claims 9, 30, and 62 relative to a composition containing more concentrated amounts of the colored compounds of Ohtake or compositions containing larger particle sizes than those of Ohtake based on the Tyndall effect expected in Ohtake which gives a milky color, i.e. reduced color.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the metals of the instant claim 63 in the method of page 6 of Ohtake because Ohtake encompasses the use of all transition metals there.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the dispersants of the instant claims 12-13, 24-25, 27-29, 52-53, 55-57, and 70-75 because page 7, lines 17-22 broadly encompasses these compounds and Cyphers (column 2, line 69 through column 3, line 42) and Blackborow (page 2, lines 3-42 and the remainder of

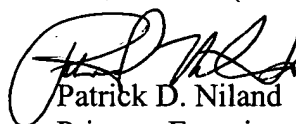
Art Unit: 1714

the document) disclose these compounds as known dispersants/emulsifiers/detergents in similar oil compositions and their benefits would have been expected in the compositions and methods of Ohtake.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrick D. Niland
Primary Examiner
Art Unit 1714